

**THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

Appellants: Bayard S. Webb, et al.
Appl. No.: 09/688,441
Conf. No.: 1896
Filed: October 16, 2000
Title: GAMING DEVICE HAVING A MULTI-ROUND BONUS SCHEME
WHEREIN EACH ROUND HAS A PROBABILITY OF SUCCESS
Art Unit: 3714
Examiner: William H. McCulloch Jr.
Docket No.: 112300-141

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

APPELLANTS' APPEAL BRIEF

Sir:

Appellants submit this Appeal Brief in support of the Notice of Appeal filed on May 16, 2006 and received by the U.S. Patent and Trademark Office on May 16, 2006. This Appeal is taken from the Final Rejection dated February 23, 2006.

A Petition for a Three Month Extension of Time to file this Appeal Brief is submitted herewith. Please charge deposit account number 02-1818 for any fees which are due in connection with this Petition and this Appeal Brief.

I. REAL PARTY IN INTEREST

The real party in interest for the above-identified patent application on appeal is IGT by virtue of an Assignment dated January 29, 2001, and recorded at the United States Patent and Trademark Office at reel 011490, frame 0615.

II. RELATED APPEALS AND INTERFERENCES

Appellants, Appellants' legal representative and the Assignee of the above-identified patent application do not know of any prior or pending appeals, interferences or judicial proceedings which may be related to, directly affect or be directly affected by or have a bearing on the Board's decision with respect to the above-identified Appeal.

III. STATUS OF CLAIMS

Claims 1 to 18 and 20 to 38 are pending in the above-identified patent application. Claims 29 to 38 stand allowed. Claim 19 has been cancelled. Claims 1 to 18 and 20 to 28 stand rejected. Therefore, Claims 1 to 18 and 20 to 28 are being appealed in this Brief. A copy of the appealed claims is attached in the Claims Appendix.

IV. STATUS OF AMENDMENTS

No amendments were made in this application after the final rejection.

V. SUMMARY OF CLAIMED SUBJECT MATTER

The following is a concise summary of the invention (and is substantially taken from pages 2 to 30 of the present application).

Many gaming machines known prior to the present invention had a primary or base game and a secondary or bonus game. These known gaming machines required the player to make a wager to play the primary or base game (such as a conventional slot game having a plurality of reels). In the play of the primary or base game, the player either won an award or did not win an award. Many of these known gaming machines provided the secondary or bonus game to the player if a triggering event occurred in the play of the primary game. In the play of many known secondary or bonus games, the player usually wins an award; and the secondary or bonus game is played to determine the amount of the award won by the player. Secondary or bonus games have become very popular in casinos. However, players sometimes become bored with secondary games. Accordingly, there is a well established continuing need in the gaming industry for gaming design manufacturers to develop new and different secondary or bonus games that provide excitement and enjoyment to players. Such secondary or bonus games generate awards for player in different ways.

In one embodiment, the gaming device of the present invention provides a game having plurality of independent rounds. The game can be implemented as a secondary or bonus game. In each round, the gaming device provides the player a group of symbols. The gaming device associates an item with at least one, a plurality of or each of the symbols of the group. This association for each round is independent of the associations for the other rounds. The player chooses one symbol from the group of symbols in each round. If the chosen symbol has the associated item, the gaming device provides the player with an award in that round. If the player chooses a symbol which does not have the associated item, the gaming device does not provide the player with an award in that round. After providing (or not providing) an award to the player for that round, the gaming device proceeds to the next independent round, if any, and proceeds as described above.

In one embodiment of the present invention, the gaming device can vary the number of symbols having an associated item in each of the plurality of independent rounds. In doing so, the gaming device can vary the percentage of symbols having an associated item and accordingly vary the likelihood of a player winning an award in each round.

In one embodiment of the present invention, a plurality of items may each be associated with one, a plurality or all of the symbols in a round. The player chooses one symbol from the group of symbols in each round. If the chosen symbol is associated with a designated one of the items, the gaming device provides the player with an award in that round. If the player chooses a symbol which is not associated with the designated item, the gaming device does not provide the player with an award in that round.

In one embodiment of the present invention, the gaming device includes a plurality of symbols, a plurality of independent rounds and an input device which enables a player to select one of symbols in each of the independent rounds. The gaming device also includes a display device which displays the plurality of symbols, and a controller. The controller is operable with the input device and the display device to randomly determine for each of a plurality of the independent rounds, whether to assign an item to at least one, a plurality of or all of the plurality of symbols, wherein the determination for each round is independent of the other rounds. The controller is also operable to assign the item to one of the symbols, to a plurality of the symbols or to all of the symbols, enable the player to select one of the symbols in each of the rounds, and provide an award to the player for each of the rounds if the player selects one of the symbols having the assigned item in that round.

In another embodiment of the present invention, the method for operating a gaming device includes (a) displaying a plurality of symbols on a display device, (b) randomly determining to assign an item to at least one, a plurality of or all of the symbols, and

- (i) if the random determination is to assign the item to one of the symbols, assigning the item to one of the symbols,

- (ii) if the random determination is to assign the item to the plurality of symbols, assigning the item to the plurality of symbols, and
- (iii) if the random determination is to assign the item to all of the symbols, assigning the item to all of the symbols.

The method further includes (c) selecting a prize, (d) enabling a player to select a symbol, providing the prize to the player if the player chooses a symbol having the assigned item, and (f) repeating steps (a) to (e) in a plurality of independent rounds, wherein the determination in each of the rounds is independent of the other rounds.

In another embodiment of the present invention, the method for operating a gaming device includes displaying a group of symbols on a display device, and randomly determining to assign an item to a percentage of the symbols of the group, wherein the percentage includes the item being assigned to at least one, a plurality of or all of the symbols. If the determination is made to assign the item to one of the symbols, the method includes assigning the item to one of the symbols. If the determination is made to assign the item to the plurality of the symbols, the method includes assigning the item to the plurality of the symbols. If the determination is made to assign the item to all of the symbols, the method includes assigning the item to all of the symbols. The method further includes determining a number of independent rounds the player plays with the assigned item and enabling the player to play the number of independent rounds, wherein the determination in each of the rounds is independent of the other rounds.

In another embodiment of the present invention, the method for operating a gaming device includes displaying a group of symbols on a display device and assigning an item to a first percentage of symbols of the group and assigning an item to a second percentage of symbols of the group. The method also includes selecting a first number of player selections of the first percentage, selecting a second number of player selections of the second percentage, adding the first number and the second number and enabling the player to select the added number of times.

In another embodiment of the present invention, the gaming device includes a group of symbols, a plurality of items, a display device; and a processor operable with the display device. The processor is operable to display the group of symbols, assign

one of the items to a first percentage of symbols of the group, and assign another one of the items to a second percentage of symbols of the group. The processor is also operable to select a first number of player selections of the first percentage, select a second number of player selections of the second percentage, add the first selected number and the second selected number and enable a player to select from the symbols the added number of times.

The gaming device and method of the present invention thus provides a multi-round game wherein each round has a probability of success. That is, the present invention provides a gaming device which varies the likelihood of a player succeeding in each round. Providing multiple rounds (and thus multiple opportunities for the player to win an award) and varying the likelihood of success among the different opportunities provides a gaming device manufacturer the flexibility of providing relatively high and low value awards in one game. That is, the gaming device manufacturer can guarantee success in a round by assigning an appropriate prize in that round, wherein the assigned prize ensures that the game does not become unprofitable.

A further summary of the invention by way of reference to the drawings and specification for each of the independent claims and each means plus function claim may be found in Appendix A to this Brief.

Although specification citations are given in accordance with C.F.R. 1.192(c), these reference numerals and citations are merely examples of where support may be found in the specification for the terms used in this section of the Brief. There is no intention to suggest in any way that the terms of the claims are limited to the examples in the specification. As demonstrated by the references numerals and citations below, the claims are fully supported by the specification as required by law. However, it is improper under the law to read limitations from the specification into the claims. Pointing out specification support for the claim terminology as is done here to comply with rule 1.192(c) does not in any way limit the scope of the claims to those examples from which they find support. Nor does this exercise provide a mechanism for circumventing the law precluding reading limitations into the claims from the specification. In short, the references numerals and specification citations are not to be construed as claim limitations or in any way used to limit the scope of the claims.

VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

1. Claims 1, 2, 13, 22 and 23 stand rejected under 35 U.S.C. §103(a) as being unpatentable over G.B. Patent No. 2,144,644 to Barrie (referred to herein as "Barrie") in view of U.S. Patent No. 6,149,156 to Feola (referred to herein as "Feola") and U.S. Patent No. 5,855,514 to Kamille (referred to herein as "Kamille").
2. Claims 3, 4, 11 and 12 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Barrie in view of Feola and Kamille and in further view of U.S. Patent No. 6,203,429 to Demar et al. (referred to herein as "Demar").
3. Claims 14, 17 and 24 to 28 stand rejected under 35 U.S.C §103(a) as being unpatentable over Barrie in view of Feola and Kamille and in further view of U.S. Patent No. 6,471,208 to Yoseloff et al. (referred to herein as "Yoseloff").
4. Claims 5 to 10 and 15 to 21 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Barrie in view of Kamille and Demar and in further view of Yoseloff.

VII. ARGUMENT

1. The Examiner has Incorrectly Combined Barrie, Kamille and Feola to Reject Claims 1 to 18 and 20 to 28.

Generally, the rejections of Claims 1 to 18 and 20 to 28 should be reversed at least because:

- (a) employing independent rounds in Barrie contradicts the express teachings of Barrie;
- (b) there is no specific motivation in Barrie to employ independent rounds;
- (c) there is no specific motivation to add Feola to Barrie;
- (d) assigning one item to all of the symbols in Barrie contradicts the express teachings of Barrie;
- (e) there is no specific motivation in Barrie to assign one item to all of the symbols in Barrie;
- (f) there is no specific motivation to add Kamille to Barrie;
- (g) there is no specific motivation to add Feola to Barrie in view of Kamille;
- (h) there is no specific motivation to add Demar to Barrie in view of Feola and in further view of Kamille;
- (i) there is no specific motivation to add Yoseloff to Barrie in view of Feola and in further view of Kamille; and
- (j) there is no specific motivation to add Yoseloff to Barrie in view of Kamille and in further view of Demar.

More specifically, Barrie discloses a game including a plurality of selections in the form of a first set of doors. Each selection is randomly assigned one of a plurality of different classes based on a set of overall odds for all of rounds. The class assigned to each selection is: (a) a reward class, (b) a lose class, or (c) a win class. At least one of the selections must be assigned to a win class and at least one of the selections must be assigned to a lose class in each round. The player picks one of the plurality of selections. If the class assigned to the picked selection is a reward class, the player is

provided a reward and the game ends (page 2, lines 64 to 68). If the class assigned to the picked selection is a lose class, the game ends (page 2, lines 37 to 41). If the class assigned to the picked selection is a win class, the player can accept a designated reward or attempt to obtain a larger reward and pick one of another plurality of selections (i.e., a second set of doors) (page 2, lines 41 to 52). If the player accepts the designated reward, the player is provided the designated reward and the game ends. If the player decides to pick one of another plurality of selections, the game proceeds as described above until the player is provided a reward or a lose class assigned to a player picked selection (page 2, lines 53 to 76). The outcome in each round in Barrie (except the last round) thus determines if there is a next round.

In one embodiment, Kamille discloses a selection game including a number of concealed spots. Each spot has a directional symbol, a win symbol with an associated award or a lose symbol (col. 5, lines 61 to 67). The game starts by the player selecting one spot. The directional symbol, win symbol with an associated award or a lose symbol (col. 5, lines 61 to 67) is revealed for the selected spot. If a directional symbol is revealed, taking the form of an arrow or pointer, the player is directed to select another specific spot with their next selection. The player's next selection is limited to the specific spot or spots which the directional symbol indicates. If a lose symbol is revealed, the game ends. If a win symbol is revealed, the player is provided the award associated with the win symbol and the game ends. In another embodiment of Kamille, each of the selections is associated with a win symbol, thus guaranteeing a winning outcome of the selection game. In another embodiment of Kamille, each of the selections is associated with a void or lose symbol, thus guaranteeing a losing outcome of the selection game.

Feola discloses a multi-round card game wherein the outcome of one round is independent of the outcome of any prior round. In Feola, a player chooses a number of locations on a grid of hidden randomly-selected cards, and uses the cards later revealed at these chosen locations and at other randomly selected locations to play a number of different individual games or rounds, wherein each round is independent of any other round.

Demar discloses a gaming device wherein if bonus symbols are selected in a basic mode, a bonus mode is triggered. In the bonus mode, the same or a different game is implemented employing a variable probability trial procedure in which the player continues to play and receive awards until a losing combination occurs. Demar discloses utilizing tables for selecting values based on probabilities.

Yoseloff discloses a gaming device including a first and second gaming segment, wherein outcomes of the first gaming segment are based on random symbol selections. The gaming device enables a player to play the first game segment, wherein if a predetermined qualifying outcome is achieved, the player is awarded a first payout. If the player obtains a predetermined qualifying outcome in the first game segment, the gaming device enables the player to play a second game segment. The qualifying outcome in the first game segment determines the number of rounds to play in the second game segment.

A. Employing Independent Rounds in Barrie Contradicts the Express Teachings of Barrie

The February 23, 2006 Final Office Action stated that:

Barrie's disclosure teaches displaying a plurality of symbols (doors) on a display (Figure 3); a plurality of rounds (Figures 9 & 9A; page. 2, lines 23 to 76); a means for enabling a player to select one of the symbols in each of the rounds (page 1, lines 42 to 47); a display device operable for displaying the plurality of symbols (Figure 1); and a controller operable with the selection means and the display device to randomly assign an item to at least one, a plurality of or all of the plurality of symbols, to enable the player to select one of the symbols in each of the rounds, and to provide an award to the player if the player selects one of the symbols having an assigned item (Figure 2; page 1, lines 48 to 54 and page 2, lines 6 to 22). Barrie does not describe the use of independent rounds or determining whether to assign an item to all of the plurality of symbols. Feola discloses a selection game having multiple rounds. Feola's device employs independent rounds (col. 1, lines 56 to 67). Feola states that a player does not need to play an earlier round in order to play a later round. The result is that the game is made more interesting and exciting because a player can win in later rounds even if he loses in an earlier round (col. 1, lines 64 to 67). Thus, it would have been obvious to one of ordinary skill in the art at the time of invention to modify the gaming device of Barrie, wherein a player participate in multiple rounds, to add the feature of making the rounds independent.

In essence, Feola teaches that giving a game player multiple chances to win will keep the player interested in the game. Barrie teaches that the primary object of his invention is to provide players a more "imaginative display" than other games, by providing a "dramatic narration involving chance" (page 1, lines 26 to 34). Though Barrie does not disclose independent rounds, the combination of Barrie with Feola to include independent rounds does not diminish the artistic objectives or intended purposes of Barrie, but instead offers an improvement to players' experience by allowing them to win games independently. As discussed above, these independent rounds are known to keep players interested in a playing a particular game, and since this is a major objective of those skilled in the art, it would have been an obvious modification to Barrie.

The Examiner admits that Barrie does not teach the use of independent rounds. The Examiner reasons that it would have been obvious to one of ordinary skill in the art to modify the gaming device of Barrie (wherein a player participates in multiple rounds) to

add the feature of Feola (wherein a plurality of rounds are independent) to keep players interested in playing the game of Barrie. Appellants disagree.

It is well established that the Examiner has the initial burden of proving a *prima facie* case of obviousness. In making this determination, the question for the Examiner is not whether the differences between the prior art and the claims themselves would have been obvious, but whether the claimed invention as a whole would have been obvious.

It is also well established that the combination of references used to reject the claims cannot ignore the intended purpose of the primary reference, destroy the intended purpose of the primary reference, or change the principle of operation of the primary reference. If the proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 221 U.S.P.Q 1125 (Fed. Cir. 1984). Additionally, if the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 123 U.S.P.Q 349 (CCPA 1959).

One of ordinary skill in the art would not have been motivated to employ independent rounds in Barrie because this would substantially change and destroy the functionality and intended purpose of Barrie. As described above, Barrie discloses a game wherein the advancement to each subsequent round depends on the successful outcome in the immediately prior round (and of course each of the rounds before that). For example, if the player selects a door associated with a lose class in Barrie, the game ends (page 2, lines 37 to 41). If the independent rounds feature of Feola were added to Barrie, then if the player selects a door associated with a lose class in a round, the modified Barrie game would not end, and the modified Barrie game would enable the player to pick another selection in the next round. That is, the Barrie game includes an element of risk (i.e., with each door selected, the player risks that the selected door is associated with a lose class, which ends the game), but the modified Barrie game does not include any element of risk (i.e., each selected door presents no risk to the player because even if the player selects a door associated with a lose class, the

modified Barrie game would not end, but would proceed to the next round). Accordingly, such a modification would destroy the functionality of the Barrie game and contradicts the express teaching of Barrie.

Moreover, Barrie includes a set of overall odds at the beginning of the game that are based on which classes are assigned to which selections in all of the possible rounds. These odds dictate that a certain percentage of plays on average will result in wins and a certain percentage of plays on average will result in losses. If the independent round feature of Feola were added to the Barrie game, then the overall odds structure for the Barrie game would be destroyed. Accordingly, Appellants respectfully submit that adding the independent round feature of Feola into the Barrie game destroys the intended purpose and functionality of Barrie and is thus improper. For these reasons alone, the rejection of Claims 1 to 18 and 20 to 28 should be reversed.

B. There is No Specific Motivation in Barrie to Employ Independent Rounds

Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. Particular findings must be made as to why the skilled artisan, with no knowledge of the claimed invention, would have selected the components of the present invention for combination in the manner claimed. The Examiner can satisfy obviousness only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the teachings of the references in the manner of the claimed invention. For obviousness, teachings of references can be combined only if there is some suggestion or incentive to do so.

By adding the independent round feature in Barrie, the Examiner ignores Barrie's express teaching of a game wherein the advancement to each possible subsequent round depends on the successful outcome in the immediately previous round (and of course all rounds before that). The Examiner does not explain why one of ordinary skill

in the art would disregard this express teaching of Barrie. The Examiner merely concludes that since a primary teaching of Barrie is to provide players a more "imaginative display" than other games, by providing a "dramatic narration involving chance". The Examiner further concludes that since independent rounds are known to keep players interested in playing a particular game, the combination of Barrie and Feola offers an improvement to players' experiences by allowing them to win games independently. Appellants submit that such a generic reasoning for the motivation to combine the references is improper. In addition to the unfeasibility of this modification (as described above), such a general reason of improving players' experiences can be applied to nearly any problem in the gaming industry. Improving a players experiences is not a specific reason or explanation of the motivation for combining these references. For at least these reasons, the rejections of Claims 1 to 18 and 20 to 28 should be reversed.

C. There is No Specific Motivation to Add Feola to Barrie

It is well established that one cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to re-create the claimed invention. Obviousness cannot be based on the hindsight combination of components selectively culled from the prior art to fit the parameters of the claimed invention. Virtually all inventions are combinations of old elements. It is impermissible to use the claims as an instruction manual or template to piece together the teachings of the prior art to render a claimed invention obvious. An Examiner may often find every element of a claimed invention in the prior art. However, if merely identifying each claimed element in the prior art was sufficient to negate patentability, very few patents would ever issue. Rejecting patent claims solely by finding "prior art corollaries" for the claimed elements permits an examiner to use the claimed invention itself as a blueprint for piecing elements in the prior art together. When the Examiner fails to explain how the skilled artisan would have been motivated by the prior art to make the claimed combination, an inference arises that the obviousness determination has been made in hindsight, which is impermissible.

The Examiner ignores these well established principals and relies on improper hindsight as a justification for the obviousness rejection. The Examiner improperly used hindsight reasoning by combining the path/advancement game of Barrie with a series of independent events game of Feola. That is, the Examiner improperly used hindsight reasoning by combining a game wherein the advancement to each subsequent round depends on the successful outcome in the immediately prior round (i.e., Barrie) with a game wherein the outcome of each round is independent of the outcomes of any other round (i.e., Feola). To form the basis for this rejection, the Examiner used references that each include only certain elements of Claims 1 to 18 and 20 to 28, but these references do not teach, disclose or suggest the specific combination of the elements of Claims 1 to 18 and 20 to 28. In this case, Barrie does not teach, disclose or suggest having each round independent of any previous round. Rather, as described above, Barrie teaches away from having each round independent of any previous round. Without a teaching, suggestion or motivation found either explicitly or implicitly in the references used to combine the references to form the specific combination of elements of Claims 1 to 18 and 20 to 28, the Examiner improperly used hindsight reasoning (as well as ignored the intended purpose of Barrie) as the basis for the obviousness rejection. For at least these reasons, the rejections of Claims 1 to 18 and 20 to 28 should be reversed.

D. Assigning One Item to All of the Symbols in Barrie Contradicts the Express Teachings of Barrie

The February 23, 2006 Final Office Action stated that:

Kamille discloses an analogous gaming device for playing a selection game (col. 3, line 59 to col. 4, line 3). Kamille's device includes 'win' or 'lose' outcomes. Kamille teaches that the game selections may all be winning outcomes (col. 1, line 56 to col. 2, line 3). The probability of winning is controlled, which contributes to the game's popularity. Thus, it would have been obvious to one of ordinary skill in the art at the time of invention to modify Barrie's device to add the feature of assigning an item to all of the plurality of symbols. As suggested by Kamille, the modification would allow the operator to provide a game in which some outcomes are guaranteed to win and thereby increase the popularity of the game.

The examiner notes that Kamille provides games that are "assured winners", "assured losers", or games that have a probability of winning that is greater than 0% and less than 100% (for example, col. 5, lines 21 to 26). Kamille further teaches controlling the number of winning outcomes in order to prevent unnecessarily larger payout liabilities on the part of a gaming establishment (for example, col. 2). In summary, Kamille teaches applying an item to all of the plurality of symbols in a way that is beneficial to both the game player and the gaming establishment. The examiner notes that Barrie's device could provide a round of a game wherein the player is guaranteed to win (i.e., an item is assigned to all of the plurality of symbols) without any detriment to the profitability and overall system, as long as the frequency of a winning condition is controlled, as is suggested by Kamille. Thus, the combination of Barrie and Kamille is feasible and obvious.

The Examiner admits that Barrie does not teach determining whether to assign an item or class to all of the plurality of symbols. The Examiner reasons that it would have been obvious to one of ordinary skill in the art at the time of invention to modify Barrie's game to add the feature of assigning an item or class to all of the plurality of symbols because the modification would allow the operator to provide a game in which some outcomes are guaranteed to win which thereby increases the popularity of the game. Appellants disagree.

One of ordinary skill in the art would not be motivated to assign one item to all of the symbols in Barrie at least because this would substantially change and destroy the functionality and intended purpose of the Barrie game. Barrie discloses assigning the designated object randomly to one of a plurality of classes, wherein the classes include at least a win class and a lose class. (page 1, lines 48 to 52). Barrie teaches the need for at least two classes (i.e., items of the present invention) which must each be assigned to different doors (i.e., symbols of the present invention). By requiring that at least one door be assigned to a win class and at least one door be assigned to a lose class, Barrie teaches away from the feature of assigning one class to all of the doors. If Barrie is modified by Kamille to provide a win class associated with each door in Barrie or a lose class is associated with each door in Barrie, then the premise of Barrie (i.e., the opportunity of obtaining either a win class or a lose class with each door selection) would not be feasible. Accordingly, Appellants respectfully submit that combining the

assignment of one class (or item of the present invention) to all of the doors (or symbols of the present invention) destroys the functionality and contradicts the express teachings of Barrie and is thus improper. For at least these reasons, the rejections of Claims 1 to 18 and 20 to 28 should be reversed.

E. There is No Specific Motivation in Barrie to Assign One Item to All of the Symbols in Barrie

The Examiner ignores Barrie's express teaching of assigning at least one door to a win class and assigning at least one door to a lose class. The Examiner does not explain why one of ordinary skill in the art would disregard this express teaching of Barrie. Rather, the Examiner merely concludes that since Kamille teaches applying an item to all of the plurality of symbols in a way that is beneficial to both the game player and the gaming establishment, Barrie's device could provide a round of a game wherein the player is guaranteed to win without any detriment to the profitability and overall system. In addition to the unfeasibility of this modification (as described above), this is another improper general reason and not a specific reason. The Examiner uses a general reason regarding controlling profitability of a gaming device that can be applied to just about any problem instead of a specific reason or explanation of the motivation for combining these references. Allowing an operator to provide a game in which some outcomes are guaranteed to win and thereby controlling the profitability and increasing the popularity of the game does not provide any specific reason or motivation for modifying Barrie with Kamille. For at least these reasons, the rejections of Claims 1 to 18 and 20 to 28 should be reversed.

F. There is No Specific Motivation to add Kamille to Barrie

The Examiner improperly used hindsight reasoning by combining a path/advancement game of Barrie with a probability game with insured winnings of Kamille. That is, the Examiner improperly used hindsight reasoning by combining a game wherein at least one door must be assigned to a win class and at least one door

must be assigned to a lose class (i.e., Barrie), with a game wherein one type of symbol (e.g., a winning symbol or a losing symbol) may be assigned to all of the player selectable spots (i.e., Kamille). To form the basis for this rejection, the Examiner used references that each include only certain elements of Claims 1 to 18 and 20 to 28, but these references do not teach, disclose or suggest the specific combination of the elements of Claims 1 to 18 and 20 to 28. In this case, Barrie does not teach, disclose or suggest determining whether to assign an item to all of the plurality of symbols. Rather, as described above, Barrie teaches away from assigning an item to all of the plurality of symbols. Without a teaching, suggestion or motivation found either explicitly or implicitly in the references used to combine the references to form the specific combination of elements of Claims 1 to 18 and 20 to 28, the Examiner improperly used hindsight reasoning (and again ignored the intended purpose of Barrie) as the basis for the obviousness rejection. For these reasons, the rejections of Claims 1 to 18 and 20 to 28 should be reversed.

G. There is No Specific Motivation to add Feola to Barrie in view of Kamille

The Examiner improperly used hindsight reasoning by combining the game of Barrie with the game of Feola and further combining the modified game of Barrie with the game of Kamille. In this case, as described above, the Examiner first improperly combined the path/advancement game of Barrie with a series of independent events game of Feola. Secondly, the Examiner improperly combined the modified path/advancement game of Barrie (as modified by Feola) with a probability game with insured winnings of Kamille. In forming the basis for this rejection, the Examiner used references that each include only certain elements of Claims 1 to 18 and 20 to 28, but these references do not teach, disclose or suggest the specific combination of the elements of Claims 1 to 18 and 20 to 28. Without a teaching, suggestion or motivation found either explicitly or implicitly in the references used to combine the references to form the specific combination of elements of Claims 1 to 18 and 20 to 28, the Examiner improperly used hindsight reasoning (and again ignored the intended purpose of Barrie)

as the basis for the obviousness rejection. For these reasons, the rejections of Claims 1 to 18 and 20 to 28 should be reversed.

H. There is No Specific Motivation to add Demar to Barrie in view of Feola and in further view of Kamille

As described above, the Examiner improperly used hindsight reasoning by combining the game of Barrie with the game of Feola and further combining the modified game of Barrie with the game of Kamille. The Examiner further improperly used hindsight reasoning by combining the game of Demar with the resulting modified game of Barrie. The Examiner used references that each include only certain elements of Claims 3, 4, 11 and 12, but these references do not teach, disclose or suggest the specific combination of the elements of Claims 3, 4, 11 and 12. Without a teaching, suggestion or motivation found either explicitly or implicitly in the references used to combine the references to form the specific combination of elements of Claims 3, 4, 11 and 12, the Examiner improperly used hindsight reasoning (and again ignored the intended purpose of Barrie) as the basis for the obviousness rejection. For these reasons, the rejections of Claims 3, 4, 11 and 12 should be reversed.

I. There is No Specific Motivation to add Yoseloff to Barrie in view of Feola and in further view of Kamille

As described above, the Examiner improperly used hindsight reasoning by combining the game of Barrie with the game of Feola and further combining the modified game of Barrie with the game of Kamille. The Examiner further improperly used hindsight reasoning by combining the game of Yoseloff with the resulting modified game of Barrie. The Examiner used references that each include only certain elements of Claims 14, 17 and 24 to 28, but these references do not teach, disclose or suggest the specific combination of the elements of Claims 14, 17 and 24 to 28. Without a teaching, suggestion or motivation found either explicitly or implicitly in the references used to combine the references to form the specific combination of elements of Claims

14, 17 and 24 to 28, the Examiner improperly used hindsight reasoning (and again ignored the intended purpose of Barrie) as the basis for the obviousness rejection. For these reasons, the rejections of Claims 14, 17 and 24 to 28 should be reversed.

J. There is No Specific Motivation to add Yoseloff to Barrie in view of Kamille and in further view of Demar

As described above, the Examiner improperly used hindsight reasoning by combining the game of Barrie with the game of Kamille and further combining the modified game of Barrie with the game of Demar. The Examiner further improperly used hindsight reasoning by combining the game of Yoseloff with the resulting modified game of Barrie. The Examiner used references that each include only certain elements of Claims 5 to 10 and 15 to 21, but these references do not teach, disclose or suggest the specific combination of the elements of Claims 5 to 10 and 15 to 21. Without a teaching, suggestion or motivation found either explicitly or implicitly in the references used to combine the references to form the specific combination of elements of Claims 5 to 10 and 15 to 21, the Examiner improperly used hindsight reasoning (and again ignored the intended purpose of Barrie) as the basis for the obviousness rejection. For these reasons, the rejections of Claims 5 to 10 and 15 to 21 should be reversed.

It is therefore respectfully submitted that the rejections of all of the claims should be reversed, and such decision is respectfully requested.

Respectfully submitted,

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Dated: October 16, 2006

CLAIMS APPENDIX

1. A gaming device comprising:
 - a plurality of symbols;
 - a plurality of independent rounds;
 - means for enabling a player to select one of said symbols in each of the independent rounds;
 - a display device operable for displaying said plurality of symbols; and
 - a controller operable with the selection means and the display device to randomly determine for each of a plurality of said independent rounds whether to assign an item to at least one, a plurality of or all of the plurality of symbols, wherein said determination for each round is independent of said other rounds, and upon said determination being made, to assign the item to one of said symbols, to a plurality of said symbols or to all of said symbols, to enable the player to select one of the symbols in each of the rounds, and to provide an award to the player for each of said rounds if said player selects one of the symbols having said assigned item in said round.
2. The gaming device of Claim 1, wherein said controller assigns an item to a plurality of symbols in each round.
3. The gaming device of Claim 1, wherein said controller operates with a table of randomly selectable items.
4. The gaming device of Claim 1, wherein said controller operates with a table of randomly selectable items, and wherein at least one item is adapted to be randomly selected more often than at least one other item.
5. The gaming device of Claim 1, which includes a table of numbers that designate how many rounds the player has in which to select from the plurality of symbols when said item is assigned to a percentage of symbols of said group.

6. The gaming device of Claim 5, wherein at least one number of said table is adapted to be randomly selected more often than at least one other number of said table.

7. The gaming device of Claim 5, which includes a plurality of tables of numbers.

8. The gaming device of Claim 7, wherein at least one number of each table is adapted to be randomly selected more often than at least one other number of said table.

9. The gaming device of Claim 5, which includes a quantity of tables of numbers equaling the quantity of symbols in a round.

10. The gaming device of Claim 9, wherein at least one number of a table is adapted to be randomly selected more often than at least one other number of said table.

11. The gaming device of Claim 1, which includes a table of randomly selectable prizes.

12. The gaming device of Claim 1, which includes a table of randomly selectable prizes, and wherein at least one prize is adapted to be randomly selected more often than at least one other prize.

13. A method for operating a gaming device, said method comprising the steps of:

- (a) displaying a plurality of symbols on a display device of said gaming device;
- (b) randomly determining to assign an item to at least one, a plurality of or all of said symbols, and
 - (i) if the random determination is to assign the item to one of the symbols, assigning said item to one of said symbols,
 - (ii) if the random determination is to assign the item to the plurality of symbols, assigning said item to the plurality of symbols, and
 - (iii) if the random determination is to assign the item to all of the symbols, assigning said item to all of said symbols;
- (c) selecting a prize;
- (d) enabling a player to select a symbol;
- (e) providing said prize to said player if said player chooses a symbol having said assigned item; and
- (f) repeating steps (a) to (e) in a plurality of independent rounds, wherein said determination in each of said rounds is independent of said other rounds.

14. The method of Claim 13, which includes the step of selecting a number of rounds the player plays, wherein each round to be played is associated with a percentage of symbols that have an assigned item.

15. The method of Claim 13, which includes the step of after the random determination is made to assign the item to one, the plurality or all of the symbols, selecting from a table associated with said determination, one of a plurality of probabilities that the item will be assigned according to said determination in said plurality of rounds.

16. The method of Claim 15, wherein the table includes a plurality of different probabilities.

17. The method of Claim 13, which includes the step of selecting a number of rounds to be played, wherein each round the item is assigned to a different percentage of symbols.

18. The method of Claim 17, wherein each of the different percentage of symbols is associated with a different table of probabilities determining the assignment of the item to the symbols in the plurality of rounds to be played.

19. Canceled.

20. The method of Claim 13, which includes the step of repeating steps (a) through (e) until said player selects a number of times equal to a selected number of rounds, said selected number being associated with a percentage of symbols that have an assigned item.

21. The method of Claim 13, which includes the step of repeating steps (a) through (e) until said player selects a number of times equal to a sum of a plurality of selected numbers, said selected numbers of rounds each being associated with a different percentage of symbols that have an assigned item.

22. The method of Claim 13, which includes the step of revealing that the symbol has been assigned said item when said player selects said symbol having said assigned item.

23. The method of Claim 13, which includes the step of revealing all of the symbols that were assigned said item when said player selects one of the symbols that was not assigned said item.

24. A method for operating a gaming device, said method comprising the steps of:

- (a) displaying a group of symbols on a display device of said gaming device;
- (b) randomly determining to assign an item to a percentage of the symbols of said group, wherein the percentage includes the item being assigned to at least one, a plurality of or all of the symbols, and
 - (i) if the determination is made to assign the item to one of the symbols, assigning said item to one of said symbols,
 - (ii) if the determination is made to assign the item to the plurality of the symbols, assigning said item to the plurality of said symbols, and
 - (iii) if the determination is made to assign the item to all of the symbols, assigning said item to all of the symbols;
- (c) determining a number of independent rounds the player plays with the assigned item; and
- (d) enabling said player to play said number of independent rounds, wherein said determination in each of said rounds is independent of said other rounds.

25. The method of Claim 24, which includes the step of selecting a prize.

26. The method of Claim 24, which includes the step providing said prize to said player if said player chooses a symbol having said assigned item.

27. The method of Claim 24, which includes the step of revealing that a symbol has an assigned item when said player selects a symbol having said assigned item.

28. The method of Claim 24, which includes the step of revealing that all symbols having an assigned item indeed have said assigned item when said player selects a symbol not having an assigned item.

29. A method for operating a gaming device, said method comprising the steps of:

- (a) displaying a group of symbols on a display device of said gaming device;
- (b) assigning an item to a first percentage of symbols of said group;
- (c) assigning an item to a second percentage of symbols of said group;
- (d) selecting a first number of player selections of said first percentage;
- (e) selecting a second number of player selections of said second percentage;
- (f) adding said first number and said second number; and
- (g) enabling said player to select said added number of times.

30. The method of Claim 29, which includes the step of selecting a prize.

31. The method of Claim 30, which includes the step providing said prize to said player if said player chooses a symbol having an assigned item.

32. The method of Claim 29, which includes the step of revealing that a symbol has an assigned item when said player selects a symbol having said assigned item.

33. The method of Claim 29, which includes the step of revealing that all symbols having an assigned item indeed have said assigned item when said player selects a symbol not having an assigned item.

34. A gaming device comprising:

a group of symbols;

a plurality of items;

a display device; and

a processor operable with the display device to display said group of symbols, assign one of said items to a first percentage of symbols of said group, assign another one of said items to a second percentage of symbols of said group, select a first number of player selections of said first percentage, select a second number of player selections of said second percentage, add the first selected number and the second selected number and enable a player to select from said symbols the added number of times.

35. The gaming device of Claim 34, wherein said processor is operable to select a prize.

36. The gaming device of Claim 35, wherein said processor is operable to provide the prize to the player if at least one of the player selected symbols is assigned at least one of said items.

37. The gaming device of Claim 34, wherein said processor is operable to reveal that one of said player selected symbols is assigned one of said items.

38. The gaming device of Claim 34, wherein said processor is operable to reveal that all of said symbols having assigned items indeed have assigned items when the player selected symbol is not assigned to one of said items.

APPENDIX A

Claim 1	Drawings	Specification
A gaming device comprising:	Figs. 1 & 2	Page 8, line 17 to page 11, line 5
a plurality of symbols;	Figs. 3A, 3B, 4, 5, 6, & 7	Page 4, line 18; page 14, line 5
a plurality of independent rounds;	Fig. 7	Page 4, lines 16 to 17; page 5, lines 4 to 9
means for enabling a player to select one of said symbols in each of the independent rounds;	Fig. 7	Page 14, lines 6 to 12; page 18, lines 5 to 16
a display device operable for displaying said plurality of symbols; and	Figs. 1, 2, 3A, 3B, 4, 5, 6, & 7	Page 11, line 9; page 12, lines 1 to 6
a controller operable with the selection means and the display device	Fig. 2	Page 11, lines 8 to 14; page 14, lines 6 to 12; page 18, lines 5 to 16
to randomly determine for each of a plurality of said independent rounds whether to assign an item to at least one, a plurality of or all of the plurality of symbols, wherein said determination for each round is independent of said other rounds,	Figs. 9, 10, 11, 12 & 13	Page 19, lines 11 to 13; page 21, line 8 to page 26, line 6; page 28, line 15 to page 29, line 23
upon said determination being made, to assign the item to one of said symbols, to a plurality of said symbols or to all of said symbols, to enable the player to select one of the symbols in each of the rounds,	Figs. 3A, 4, 5, 7 & 13	Page 15, lines 3 to 4; page 30, lines 1 to 7
to provide an award to the player for each of said rounds if said player selects one of the symbols having said assigned item in said round.	Figs. 3B, 6 & 13	Page 15, lines 12 to 14; page 30, lines 11 to 14

Claim 13	Drawings	Specification
A method for operating a gaming device, said method comprising the steps of:	Fig. 13	Page 28, lines 8 to 13
(a) displaying a plurality of symbols on a display device of said gaming device;	Figs. 1, 2, 3A, 3B, 4, 5, 6, & 7	Page 4, line 18; page 11, line 9; page 12, lines 1 to 6; page 14, line 5
(b) randomly determining to assign an item to at least one, a plurality of or all of said symbols, and (i) if the random determination is to assign the item to one of the symbols, assigning said item to one of said symbols, (ii) if the random determination is to assign the item to the plurality of symbols, assigning said item to the plurality of symbols, (iii) if the random determination is to assign the item to all of the symbols, assigning said item to all of said symbols;	Figs. 9, 10, 11, 12 & 13	Page 19, lines 11 to 13; page 21, line 8 to page 26, line 6; page 28, line 15 to page 29, line 23
(c) selecting a prize;	Fig. 13	Page 27, line 1 to page 28, line 5
(d) enabling a player to select a symbol;	Figs. 3A, 4, 5, 7 & 13	Page 14, lines 6 to 12; page 18, lines 5 to 16
(e) providing said prize to said player if said player chooses a symbol having said assigned item; and	Figs. 3B, 6 & 13	Page 15, lines 12 to 14; page 30, lines 11 to 14
(f) repeating steps (a) to (e) in a plurality of independent rounds, wherein said determination in each of said rounds is independent of said other rounds.	Fig. 13	Page 19, lines 11 to 13; page 30, lines 14 to 21

Claim 24	Drawings	Specification
A method for operating a gaming device, said method comprising the steps of:	Fig. 13	Page 28, lines 8 to 13
(a) displaying a group of symbols on a display device of said gaming device;	Figs. 1, 2, 3A, 3B, 4, 5, 6, & 7	Page 4, line 18; page 11, line 9; page 12, lines 1 to 6; page 14, line 5
(b) randomly determining to assign an item to a percentage of the symbols of said group, wherein the percentage includes the item being assigned to at least one, a plurality of or all of the symbols, and (i) if the determination is made to assign the item to one of the symbols, assigning said item to one of said symbols, (ii) if the determination is made to assign the item to the plurality of the symbols, assigning said item to the plurality of said symbols, and (iii) if the determination is made to assign the item to all of the symbols, assigning said item to all of the symbols;	Figs. 9, 10, 11, 12 & 13	Page 19, lines 11 to 13; page 21, line 8 to page 26, line 6; page 28, line 15 to page 29, line 23
(c) determining a number of independent rounds the player plays with the assigned item; and	Fig. 13	Page 28, lines 15 to 21;
(d) enabling said player to play said number of independent rounds, wherein said determination in each of said rounds is independent of said other rounds.	Figs. 3A, 3B & 13	Page 14, lines 6 to 12; page 15, lines 12 to 14; page 18, lines 5 to 16; page 19, lines 11 to 13; page 30, lines 11 to 21

EVIDENCE APPENDIX

This is no attached evidence.

RELATED PROCEEDINGS APPENDIX

There are no related proceedings.